

Amendment in response to
November 28, 2007 final Office action

Atty Dkt No.: 2003P04023US
Serial No.: 10/625,960

REMARKS

Claims 1 – 40 remain in the application and stand finally rejected. Claims 2 and 22 are objected to and so, are amended by this proposed amendment. Although this Response is being timely filed, the Commissioner is hereby authorized to charge any additional fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claims 2 and 22 are objected to for lacking antecedent basis for means/step “providing said text email message” Responsive thereto, claims 2 and 22 are amended to recite “providing said speech rendering of the text email message” by this proposed amendment. No new matter is added. Entry of the amendment, reconsideration and withdrawal of the objection to claims 2 and 22, as amended, is respectfully requested.

Claims 1 – 8, 10, 11, 13 – 15, 17, 18, 20 – 28, 30, 31, 33 – 35, 37, 38 and 40 are finally rejected under 35 U.S.C. §102(b) over published European Patent Application No. EP-0-865-189-A2 to Pizano et al. Claims 9, 12, 29 and 32 are finally rejected under 35 U.S.C. §103(a) over Pizano et al. in combination with published U.S. Patent Application No. 2001/0054085 to Kurgamnov. Claims 16 and 36 are finally rejected under 35 U.S.C. §103(a) over Pizano et al. in combination with U.S. Patent No. 5,349,648 to Handley. Claims 19 and 39 are finally rejected under 35 U.S.C. §103(a) over Pizano et al. alone. The final rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is **found, either expressly or inherently** described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, the “**identical invention must be shown in as complete detail** as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).” MPEP 2131 (emphasis added).

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Claim 1 recites a "method for inserting a caller's speech annotations into an original message," at line 1. *See also*, claim 21, line 1. So the claims recite, not just providing annotations, but *inserting* those annotations *into* the original message. This is done by "annotating [a] speech message with at least one speech annotation; and inserting [that] speech annotation into said original message." Claim 1 lines 4 – 5. *See also*, claim 21, lines 4 – 5.

To the applicant's remarks in the previous response, the final Office action (Final) responds to the fact "that within the system of **Pizano**, an annotation may be included in a reply however a **Pizano** reply is not an annotation" by "interpreting this to intend that a reply message within applicant's scope of invention is the annotation itself." Final, page 2, last paragraph. So, interpreting a reply message as the annotation itself, the Final reads claim 1 as "method for inserting a caller's speech [reply message] into an original message," by "annotating [a] speech message with at least one speech [reply message]; and inserting [that] speech [reply message] into said original message."

After thus interpreting a reply message, however, "the examiner does not necessarily agree or disagree with this [the examiner's own] statement, applicant is directed to the preamble of claim 1, wherein applicant claims, 'a method for inserting a caller's speech annotations into an original message.'" *Id.* (emphasis the examiner's). Then, quoting Pizano et al. out of context, the Final asserts that "**Pizano** further discloses (Abstract), 'through a standard e-mail protocol used to add voice reply messages from a message generator,'" *Id.* (emphasis the examiner's).

The complete Pizano et al. passage from which this fragment is quoted recites:

This interface is accomplished *through a standard e-mail protocol used to add voice reply messages from a message generator to the universal mailbox* through the universal messaging server as well as through a message management library contained within a mailbox access manager that provides access to message components contained in the universal mailbox.

Pizano et al. Abstract, (57), middle (quoted fragment in italics, emphasis added). Ignoring that voice reply messages are added **to the universal mailbox** changes the meaning of Pizano et al., entirely. Only by changing that meaning (i.e., by ignoring what Pizano et al. actually teaches)

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can the Final assert that, “**Pizano** provides wherein a caller can retrieve messages from a universal server and subsequently add annotation messages (e.g. comments or notes) to said retrieved messages.” Final, page 2, last line – page 3, line 2. Therefore, Pizano et al. fails to teach the present invention as recited in claims 1 – 8, 10, 11, 13 – 15, 17, 18, 20 – 28, 30, 31, 33 – 35, 37, 38 and 40.

To teach “annotating [a] speech message with at least one speech annotation; and inserting [that] speech annotation into said original message,” the Final relies on the same fragment from Pizano et al. Final, page 3, first paragraph. Specifically, ignoring that Pizano et al. teaches adding messages to the Pizano et al. universal mailbox, the Final asserts that “**Pizano** discloses a, ‘universal messaging server which provides a repository for voice, fax, e-mail, etc. This interface is accomplished through a standard e-mail protocol used to add voice reply messages..’ [emphasis supplied].” *Id.*

However, unless once again one ignores the plain teaching of Pizano et al., that the voice reply messages are added to the Pizano et al. universal mailbox, “[t]his passage clearly [fails to disclose] wherein input voice messages are remotely accessed and further annotated with voice reply messages by means of insertion.” *Id.* Adhering to what Pizano et al. teaches, even if one were to concede, *arguendo*, that Pizano et al. “voice reply messages from a message generator” were annotations, Pizano et al. teaches adding those annotations “from a message generator to the universal mailbox.” *Supra.* This is very different from “inserting a caller’s speech annotations into an original message,” as recited by claim 1, for example. Therefore, Pizano et al. fails to teach the present invention as recited in claims 1 – 8, 10, 11, 13 – 15, 17, 18, 20 – 28, 30, 31, 33 – 35, 37, 38 and 40.

Next, the Final asserts that “[i]n the Abstract (as cited above) as well as on page 2, lines 17-22, **Pizano** discloses the retrieval of, as well as the annotation of text portions of e-mail messages stored on a universal messaging server.” Final, page 3, second paragraph. This Pizano et al. passage does not even mention annotations; but instead,

Some of the systems described in “Unified Messaging” also provide support for remote access of e-mail messages. However, this support is based on text-to-speech conversion only and is limited to the text portion of the message body.

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The present invention [Pizano et al.] seeks to extend this functionality [remote access] to every message class in the system, and to enhance it by incorporating the use of fax as away to provide visual feedback on the content of the message. For example, an image or a video could be provided.

page 2, lines 17 – 22. There is nothing in using “fax as away to provide visual feedback on the content of ... an image or a video” to teach or suggest adding and inserting annotations to/in messages. Applicant notes that “Unified Messaging” refers to “Unified Messaging” Computer Telephony Magazine, August 1996. *Id.*, line 11. Moreover, as noted hereinabove, Pizano et al. teaches adding voice reply messages to a universal mailbox, not adding annotations to those messages. Therefore, Pizano et al. fails to teach “inserting a caller’s speech annotations into an original message,” by “annotating [a] speech message with at least one speech annotation; and inserting [that] speech annotation into said original message.” Claim 1, *Supra*. Therefore also, Pizano et al. fails to teach the present invention as recited in claims 1 – 8, 10, 11, 13 – 15, 17, 18, 20 – 28, 30, 31, 33 – 35, 37, 38 and 40.

Finally, the Final acknowledges that “it might be an accurate contention that **Pizano** fails to provide annotations in the form of user entered notes and comments,” but contends that “this defining feature is simply not conveyed within the claims of applicant’s application.” Final, page 3, last paragraph. More specifically, the applicant noted in the previous amendment that with a Pizano et al. system, “a telephone user, who is receiving an email message over a voice connection using the TTS conversion provided by the **Unified Messaging system, has no way of annotating the message being delivered with notes and comments.**” Application, page 2, lines 3 – 6 (emphasis added). Contrary to the above contention from the Final, claim 14 recites “converting said speech annotations to text.” *See also*, claims 15, 16, 34, 35 and 36. Converting speech annotations to text and “inserting [that text] annotation into said original message” encompasses providing “annotations in the form of user entered notes and comments.” Certainly, accessing messages, even dynamically annotated images in a Pizano et al. universal mailbox, and responding to those messages by adding the response to the mailbox, is different than allowing someone to edit (“converting said speech annotations to text”), and insert edits (text), into the original message as recited in the claims. Therefore, providing annotations in the form of user entered notes and comments is

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conveyed within the claims of applicant's application, at least in claims 15, 16, 34, 35 and 36.

However, ignoring these claims 15, 16, 34, 35 and 36, as well as the fact that Pizano et al. teaches adding messages (including voice reply messages) to a universal mailbox, the Final concludes that "[t]he claim language calls for **inserting user-defined voice messages**, in which Pizano supplies in the form of messages 'pulled' from a message generator." Final, page 3, last sentence (emphasis added).

Nowhere do any of the claims recite "inserting user-defined voice messages." Thus, it is apparent that the present claims are being rejected based on something that is not recited in any of the claims. Furthermore, regardless of whether Pizano et al. teaches "inserting user-defined voice messages," Pizano et al. fails to teach the present invention as recited in claims 1 - 8, 10, 11, 13 - 15, 17, 18, 20 - 28, 30, 31, 33 - 35, 37, 38 and 40. Reconsideration and withdrawal of the final rejection of claims 1 - 8, 10, 11, 13 - 15, 17 - 28, 30, 31, 33 - 35 and 37 - 40 under 35 U.S.C. §§102(b) and/or 103(a) is respectfully requested.

Regarding the final rejection of claims 9, 12, 16, 19, 29, 32, 36 and 39 under 35 U.S.C. §103(a) over Pizano et al. in combination with Kurgamnov or Handley; neither Kurgamnov nor Handley adds what is missing from Pizano et al. to result in the present invention as recited in claims 1 and 20, much less in claims 9, 12, 16, 19, 29, 32, 36 and 39, which depend from claims 1 and 20. Therefore, Pizano et al. in combination with Kurgamnov or Handley or any other reference of record fails to result in the present invention as recited in claims 9, 12, 16, 19, 29, 32, 36 and 39. Reconsideration and withdrawal of the final rejection of claims 9, 12, 16, 19, 29, 32, 36 and 39 under 35 U.S.C. §103(a) is respectfully requested.

The applicant thanks the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicant respectfully requests that the Examiner enter the amendment, reconsider and withdraw the objection of claims 2 and 22,

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reconsider and withdraw the final rejection of claims 1 – 40 under 35 U.S.C. §§102(b) and 103(a) and allow the application to issue.

As the applicant has previously noted, MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

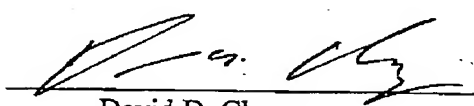
If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added.) The applicant believes that the written description of the present application is quite different than and, not suggest by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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(Date)

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